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IN THE

Supreme Court of the United States

October Term, 1970

No. 338

BLONDER-TONGUE LABORATORIES, INC.,
Petitioner,

vs.

UNIVERSITY OF ILLINOIS FOUNDATION, and
JFD ELECTRONICS CORPORATION,
Respondents.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

BRIEF OF RESPONDENT JFD ELECTRONICS CORPORATION

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BRIEF OF RESPONDENT JFD ELECTRONICS CORPORATION

Counterstatement of the Case and Summary of Argument

INTRODUCTION

The University of Illinois Foundation (hereinafter Foundation) brought suit for infringement of two of its patents in the home television receiving antenna field, against Petitioner, Blonder-Tongue Laboratories, Inc. (hereinafter BT) and a customer of BT. After BT had subjected itself to the jurisdiction of the Court, the customer was dropped as a party defendant.

In addition to answering the Foundation's Complaint and counterclaiming against the Foundation, BT counterclaimed against the Foundation and your Respondent, JFD

Electronics Corporation (hereinafter JFD). JFD is a licensee under the Foundation patents involved herein. Its license is non-exclusive. *Channel Master Corp.* v. *JFD Electronics Corp.*, 260 F. Supp. 568 (E.D.N.Y. 1966); reargument denied, 262 F. Supp. 292 (E.D.N.Y. 1967). BT accused JFD of unfairly competing against BT and charged JFD with violating the anti-trust laws. In addition, BT accused JFD of infringing one of BT's own patents.

With respect to JFD, the District Court dismissed all of BT's counterclaims, and this was sustained by the United States Court of Appeals for the Seventh Circuit.

QUESTION NO. 1 — (Re: *Triplett* v. *Lowell*)

This Court requested the parties to present arguments as to whether *Triplett* v. *Lowell* should be adhered to. *Triplett* should stand; patents in general, and *in rem* invalidity in particular, are subjects which the Congress of the United States has pre-empted, *Nickerson v. Kutschera*, 390 F.2d 812 (3 Cir. 1958). Furthermore, the legislative history of the Patent Act requires that *Triplett* be upheld. *United States v. Public Utility Comm. of Calif.*, 345 U.S. 295, 313 (1953).

QUESTION NO. 2

In view of our position on Question No. 1, Question No. 2 is moot.

QUESTION NO. 3 — (Re: *Isbell patent*)

This Question concerns a conflict in decisions between two United States Circuit Courts of Appeals, involving the validity of the Foundation's patent. JFD is a non-exclusive licensee under the patent and relies upon and refers to the argument of the Foundation in support of the validity of the patent.

BT also attempts to draw an alleged deprivation of due process at trial into the language of Question No. 3, although the language of the Question will not support this. BT complains about the trial being conducted without an allegedly important expert witness being present. Yet, BT made no offer of proof as to the damage it suffered and cannot now be heard to complain. *Cash v. Murphy*, 339 F.2d 757, 758 (5 Cir. 1964). BT did actually have a substitute expert, Blonder, who was qualified as an expert during the testimony. Also, BT draws into this question and charges that the Court excluded testimony, which BT was not entitled in any event to elicit.

QUESTION NO. 4 — (*Fraud in the Patent Office*)

This Question relates only to the effect of an alleged fraud in the Patent Office with respect to the Foundation's patent. BT's Brief extensively expands the scope of this question. However, such expansion is improper. See, Supreme Court Rule 40(d)(2); *General Talking Pictures Corp.* v. *Western Electric Co.*, 304 U.S. 175, 179 (1938).

With respect to the alleged fraud, JFD had no involvement in the preparation or prosecution of the Foundation's patent application in the U.S. Patent Office, had no reason to challenge the patent, and it had no knowledge, notice or reason to inquire as to the manner in which the patent had been acquired.

The Question presented by Petitioner to this Court is one of fraud by the Foundation in procuring this patent. BT, under the guise of this Question drags in an extensive review of evidence which purports to show that JFD is guilty of unfair competition and which is wholly unrelated to the alleged fraud that is the subject of this Question.

Both levels of Courts below found that JFD had not committed any acts of unfair competition or violations of

the antitrust laws. Since BT has presented no basis for finding the decisions of both of these levels of Courts clearly erroneous, their decisions should be affirmed. *Faulkner* v. *Gibbs*, 338 U.S. 267, 268 (1949); *Graver Tank & Mfg. Co.* v. *Linde Air Products Co.*, 336 U.S. 271, 275 (1949).

Furthermore, BT presented virtually no evidence to support its claim of violation of the anti-trust laws and failed to even make a *prima facie* showing of a violation.

QUESTION NO. 5 — (Re: *Petitioner's Blonder-Schenfeld Patent*)

BT charges that the failure of the District Court to make specific findings as to the prior art requires that there be a completely new trial of the issue of the invalidity of its Blonder-Schenfeld patent or that this Court review the prior art and hold that the patent is valid. Since BT's only charge here relates to the District Court's having failed to make the required findings, and since the Court of Appeals treated the District Court's findings as sufficient to enable that Court to affirm the District Court, and since the Court of Appeals reviewed the patent and itself made findings which cured any defects if they existed in the District Court's Opinion, and since two Courts have reviewed the facts and found that BT's patent is invalid over the prior art. The decision below should be affirmed.

ARGUMENT

QUESTION NO. 1

***Triplett* v. *Lowell* should be upheld.**

JFD, a non-exclusive licensee of the Foundation, which owns the Isbell patent involved in this Appeal, relies upon the argument of the Foundation with respect to validity of its patent. However, pursuant to the Court's request JFD

has the following additional comments with respect to the holding in *Triplett* v. *Lowell*, 297 U.S. 638 (1936).

Triplett permits a patent owner, whose patent has been declared invalid in prior litigation with one party, to relitigate the validity issue in an action against a different party. This is in conformity with the rule of mutuality of estoppel, which is an important adjunct of the doctrines of res adjudicata and collateral estoppel. Since the patent owner's opponent in the second action would not be bound by a holding in the first action that the patent was valid, he should not be able to take advantage of a holding in the first action that the patent was invalid. If a patent owner were hereafter to be bound by the first judicial holding of invalidity of his patent, as an overruling of *Triplett* would require, his patent would always thereafter be invalid. The patent would be invalid, *in rem*.

In the context of the law on *res adjudicata* at the time of the enactment of the various patent acts and in the context of the presentation at various times to Congress of proposed *in rem* legislation which Congress has failed to enact but is presently considering, the reversal of *Triplett* would amount to enactment of new legislation, a congressional rather than a judicial function.

This Court stated in *Triplett*, at 297 U.S., p. 643, that forbidding the patent owner to bring a further action against another party, based upon a patent previously declared invalid, would require a "legislative command".

Under Article I, Section 8, Clause 8, of the Constitution,[1] Congress is empowered to establish the patent system. Pursuant to that authorization, Congress has passed many Patent Acts, the most recent of which is Title 35 of the United States Code, 66 Stat. 792, enacted July 19, 1952.

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[1] . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries; . . .

The patent system is a creature of statute law and has no root in the common law. Congress, which created the right and the remedy (action for infringement) in the same statute, may of course change the statute to apply a rule of law with respect to *res adjudicata* different from that which attached to the statute at the time it was enacted and reenacted. It has not chosen to do so, although it has been presented with the opportunity.

The legislative history of the present Patent Act, 35 U.S.C., shows that *Triplett* must be affirmed. The only section in the version of the Patent Act that existed when *Triplett* was decided, and that dealt with the patent owner's right to relitigate a patent declared invalid, namely R.S. 4917, Act of 1870, c.230, Sec. 54, 16 Stat. 206, permitted relitigation of a patent that had been previously declared invalid. See *Triplett,* at 297 U.S., p. 643.

When the present version of the Patent Act, now 35 U.S.C., which succeeded the Act of 1870, was under consideration, Congress specifically considered the problem of relitigation of patents that had been declared invalid, and reconsidered the principle in *Triplett*, and enacted Sections 253[2] and 288[3], which advise a patent owner to disclaim those claims of his patent that had been declared invalid, under certain penalties if he fails to do so, but which do not forbid him from relitigating the same patent.

The Patent Subcommittee of the Judiciary Committee of the House of Representatives specifically considered enacting *in rem* invalidity, i.e., prohibiting a patent owner

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[2] DISCLAIMER

Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, and recorded in the Patent Office; and it shall thereafter be considered as part of the original

from reasserting a patent that had been declared invalid, and specifically decided that such a penalty should not be inflicted upon a patent owner. In Report of the House of Representatives, No. 1923, 82d Cong., 2d Sess., May 12, 1952, the relevant portions of which are quoted in Federico, "Commentary on the New Patent Act", Title 35 of the United States Code Annotated, Vol. I, at pp. 47-49, the Subcommittee stated, with respect to the disclaimer sections 35 U.S.C. Secs. 253, 288:

> "Other provisions [Secs. 253, 288] of the bill [which was enacted as 35 U.S.C.] take care at least as well as is done in the present law [Act of 1870] of the possibility of a patentee suing again after his patent has been held invalid. That can be done today and *no change is made in that situation*, except that certain provisions [Secs. 253, 288] tend to deter doing such a thing." (Emphasis supplied)

It was the intent of Congress at the time that the present Patent Act was enacted, that *Triplett* not be overruled, and such a clear legislative intent should be adhered to. *United States* v. *Public Utility Com. of Calif.* 345 U.S. 295, 313 (1953); *U.S.* v. *Spelar*, 338 U.S. 217, 219-221 (1949); *Takao Ozawa* v. *United States*, 260 U.S. 178, 194 (1922). Congress must be presumed to have wanted *Triplett* to stand. *Toilet Goods Assn.* v. *Finch*, 419 F. 2d 21, 27 (2 Cir. 1969).

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patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted. July 19, 1952, c. 950, § 1, 66 Stat. 809.

[3] § Action for Infringement of a Patent Containing an Invalid Claim

Whenever, without deceptive intention, a claim of a patent is invalid, an action may be maintained for the infringement of a claim of the patent which may be valid. The patentee shall recover no costs unless a disclaimer of the invalid claim has been entered at the Patent Office before the commencement of the suit. July 19, 1952, c. 950, §1, 66 Stat. 813.

The Act of 1870 did not provide for *in rem* invalidity of a patent. After *Triplett*, the Congress, with awareness of the holding in *Triplett*, as shown by the excerpt from the Committee Report, supra, enacted a statute, which repeated the earlier statute with respect to *in rem* invalidity and acquiesced in and did not overrule *Triplett*. See *Takao Ozawa* v. *United States*, 260 U.S. 178, 194 (1922). A reversal of *Triplett* would now be judicial legislation rather than judicial construction. The present Patent Act must be deemed to incorporate the judicial construction that *in rem* invalidity does not apply to patents. *Charles H. Demarest, Inc.* v. *United States*, 174 F. Supp. 380, 392 (U.S. Customs Ct. 1959); *Mustard* v. *Elwood*, 223 Fed. 225, 227 (9 Cir. 1915); *Mrugala* v. *City of Boston*, 330 Mass. 707, 115 N.E. 2d 148 (1953).

Such reversal of *Triplett* is not required by any of the protective clauses of the constitution such as the Bill of Rights. There is nothing about the present patent statute and the prior *Triplett* holding applicable thereto which raises any question of due process or equal protection of the laws.

The President of the United States appointed a Commission on the Patent System to propose improvements in that system. In Recommendation XXIII of its Report, "To Promote The Progress of . . . Useful Art", *Report of the President's Commission on the Patent System* (U.S. Govt. Printing Office, Washington, 1966), p. 38, the Commission recommended adoption of *in rem* invalidity of a patent.[4] Pursuant thereto, Bills were introduced into both Houses of the Congress during both of the 90th and 91st

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[4] XXIII

A final federal judicial determination declaring a patent claim invalid shall be *in rem*, and the cancellation of such claim shall be indicated on all patent copies subsequently distributed by the Patent Office. . . .

Congresses.[5] Some of these Bills contained a new Sec. 294, specifically instituting *in rem* invalidity of patents. See S 1042, 90th Cong., 2d Sess. (1967), Sec. 294;[6] HR 5924,

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[5] During the 90th Congress, 1st Session, in 1967, the following Bills to revise the Patent Act were introduced: S 1042; S 1691; S 2164; S 2957; HR 5924; HR 6043; HR 6975; HR 7454; HR 11447 and HR 13951.

In the 90th Congress, 2nd Session 1968, one Bill to revise the Patent Act was introduced: S 3892.

In the 91st Congress, 1st Session, in 1969, the following Bills to revise the Patent Act were introduced: S 1246; S 1569; S 2756 and HR 12280.

[6] "§ ESTOPPEL AND CANCELLATION

"(a) In any action in a Federal court in which the issue of the validity or scope of a claim of a patent is properly before the court, and the owner of the patent as shown by the records of the Patent Office is a party or has been given notice as provided in subsection (c) of this section, a final adjudication, from which no appeal has been or can be taken, limiting the scope of the claim or holding it to be invalid, shall constitute an estoppel against the patentee, and those in privity with him, in any subsequent Federal action, and may constitute an estoppel in such other Federal actions as the latter court may determine, involving such patent. Within thirty days of such adjudication the clerk of the court shall transmit notice thereof to the Commissioner, who shall place the same in the public records of the Patent Office pertaining to such patent, and endorse notice on all copies of the patent thereafter distributed by the Patent Office that the patent is subject to such adjudication.

"(b) In any action as set forth in subsection (a) of this section, upon a final adjudication from which no appeal has been or can be taken that a claim of the patent is invalid, the court may order cancellation of such claim from the patent. Such order shall be included in the notice to the Commissioner specified in subsection (a) of this section, and the notice of cancellation of a claim shall be published by the Commissioner and endorsed on all copies of the patent thereafter distributed by the Patent Office.

"(c) In any action in a Federal court in which the validity or scope of a claim of a patent is drawn into question, the owner of the patent, as shown by the records of the Patent Office, shall

90th Cong., 2d Sess. (1967), Sec. 294;[6] and S 3892, 90th Cong., 2d Sess. (1968) Sec. 294.[7]

A new Patent Act is still under consideration. Because a number of already proposed revisions of the Patent Act

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have the unconditional right to intervene to defend the validity or scope of such claim. The party challenging the validity or scope of the claim shall serve upon the patent owner a copy of the earliest pleadings asserting such invalidity. If such owner cannot be served with such pleadings, after reasonable diligence is exercised, service may be made as provided for in the Federal Rules of Civil Procedure and, in addition, notice shall be transmitted to the Patent Office and shall be published in the Official Gazette."

[7] "§ CANCELLATION BY COURT

"(a) In any action in a Federal court in which the issue of the validity of a claim of a patent is drawn into question, and the owner of the patent is shown by the records of the Patent Office is a party or has been given notice as provided in subsection (b) of this section, the court may, upon final adjudication, from which no appeal has been or can be taken, holding the claim to be invalid, after such claim has previously been held invalid on the same ground by a court of competent jurisdiction from which no appeal has been or can be taken, order cancellation of such claim from the patent. Within thirty days of such order the clerk of the court shall transmit notice thereof to the Commissioner, who shall place the same in the public records of the Patent Office pertaining to such patent, and notice of cancellation of the claim shall be published by the Commissioner and endorsed on all copies of the patent thereafter distributed by the Patent Office.

"(b) In any action in a Federal court in which the validity of a claim of a patent is drawn into question, the owner of the patent, as shown by the records of the Patent Office, shall have the unconditional right to intervene to defend the validity of such claim. The party challenging the validity of the claim shall serve upon the patent owner a copy of the earliest pleadings asserting such invalidity. If such owner cannot be served with such pleadings, after reasonable diligence is exercised, service may be made as provided for in the Federal Rules of Civil Procedure and, in addition, notice shall be transmitted to the Patent Office and shall be published in the Official Gazette."

cover *in rem* invalidity, this feature is presently still under consideration by the Congress. This Court should not rule on this issue, which has for the present, been preempted by the Congress, at least until Congress makes a new enactment relating to *in rem* invalidity. *Nickerson* v. *Kutschera*, 390 F.2d 812, 815 (3 Cir. 1958).

The United States Patent Office, an agency in the United States Department of Commerce, has also recognized that *in rem* invalidity is properly the subject of a legislative enactment and, therefore, should be left in the hands of Congress.[8] The Executive Branch of the Government sought a holding with respect to *in rem* invalidity from the Legislature, not the Courts.

Similarly, the American Bar Association, Section of Patent, Trademark and Copyright Law, in the Report of its Committee 101, which was issued in 1968, Subject 24,

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[8] In an undated letter, apparently sent in the later part of 1967 or the earlier part of 1968, by Maurice A. Crews, Acting Director. Office of Legislative Planning, of the United States Patent Office, to the Chairman, Committee on the Judiciary, United States Senate, at page 23, and commenting upon both S 2597 and S 1042, which were then before the 90th Congress, Mr. Crews wrote:

> "RECOMMENDATION NO. XXIII: IN REM INVALIDITY
>
> Under existing law, a court decision holding a patent claim invalid does not necessarily preclude later action based on the infringement of the claim.
>
> Adopting the Commission's recommendation for *In rem* invalidity, the Patent Reform bill provides that a final federal judicial determination 'limiting the scope of a claim or holding it to be invalid, shall constitute an estoppel' against the patentee, and further provides that a court may order cancellation from the patent of any claim finally held invalid (§ 294).
>
> S. 2597 has no comparable provision.
>
> The Department is in complete agreement with the reasoning of the Commission that once a patentee has had his day in court, he should not be allowed to harass others on the basis of an invalid claim. Thus, we support the estoppel and cancellation provisions of S. 1042."

Proposed Resolution 22, all on p. 33 of the Report, reviewed S 1042 as it relates to *in rem* invalidity and recommended against adoption of such a statute.[9] It thus recognizes that *in rem* invalidity is properly the subject of legislation.

There is no compelling reason for disregarding the clear Congressional rejection of *in rem* invalidity nor for disregarding the Congressional preemption of this presently actively considered issue.

Furthermore, the whole problem of *in rem* invalidity can be considered de minimis in the context of administration of the Federal Court system. Currently the present rule on *in rem* invalidity affects less than three percent of all patent cases, and patent cases constitute about 1.2% of all civil cases filed. This problem, therefore, affects less than one case in 1,000, of which less than half are carried through to a decision on the merits.[10]

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[9] SUBJECT 24: IN REM INVALIDITY AND PATENT SCOPE
PROPOSED RESOLUTION 22

RESOLVED, that the Section disapproves legislation which would create an estoppel against the patentee, and those in privity with him, arising out of an adjudication limiting the scope of any patent claim or holding it invalid, and

FURTHER RESOLVED, that the Section is opposed to Section 294 of S.1042.

Past Action: None

[10] From 1949 to 1958, only 2.7% of all patent cases involved patents previously held invalid. *An Analysis of Patent Litigation Statistics*, Staff Report of the Subcommittee on Patents, Trademarks and Copyrights of the Committee on the Judiciary (1961). If the 2.7% is assumed to be constant, only about 0.03% of all civil cases involve such patents since patent cases comprise about 1.2% of all civil cases filed in the last decade. Annual Reports, 1969 Administrative Office of the United States Courts. Moreover, less than half of the 2.7% are carried through to a decision on the merits and of those which were, more than 25% were held valid. Rollins, *In Rem Invalidity: A Solution In Search Of A Problem*, 52 J.P.O.S. 561, 569 (1970).

A further exposition of reasons for not overruling *Triplett* appears in *Technograph Printed Circuits Ltd.* v. *United States,* 372 F.2d 969, 977 (Ct. Cl. 1967).

In light of the foregoing, it is submitted that the holding in *Triplett* should be upheld.

QUESTION NO. 2

In view of the discussion of Question No. 1, no discussion of Question No. 2 is required.

QUESTION NO. 3 — *The Isbell Patent is Valid.*

JFD is the nonexclusive licensee of the Foundation under the Isbell patent and relies on the Foundation's argument in support of the validity of the patent. However, JFD has the following comments concerning some of the points raised by BT.

Petitioner Was Not Deprived of Due Process at the Trial of this Action.

The text of Question 3, which appears on Page 4 of BT's Brief, does not relate to or even mention any deprivation of due process at the trial of this action. Thus, this Court should not even consider that matter. See, Supreme Court Rule 40(d) (2); *General Talking Pictures Corp.* v. *Western Electric Co.,* 304 U.S. 175, 179 (1938); *Dickinson Industrial Site* v. *Cowan,* 309 U.S. 382, 389 (1940); *Trailmobile Co.* v. *Whirls,* 331 U.S. 40, 50 (1947). However, because BT briefed the matter, JFD has the following comments:

After several postponements of the trial date, trial of this action began on December 28, 1967. BT maintains that the refusal of the District Court to grant a further adjournment of the trial date denied BT due process.

The Court of Appeals considered substantially the identical arguments that BT is making in this Court and held

that there had been "no abuse of discretion in proceeding with the trial." (A. 55)[11]

Turning to the merits of BT's argument, BT complains that as a result of the postponements of the trial date to December 28, it was unable to have all its witnesses present at trial. Yet, the only witness BT has shown was unavailable was its proposed expert, Dr. Chu. (A. 135, 137-39). The Record does not show that any other expert witnesses were unavailable to BT. Blonder, an expert (A. 333-35) did testify as an expert for BT.

With respect to the only witness, whose absence BT deemed sufficiently relevant to even mention at trial, Dr. Chu, BT has made no showing of how the results at the trial of this action would have been different, had Dr. Chu been present. *Cash* v. *Murphy*, 339 F.2d 757, 758 (5 Cir., 1964). See, *American Pacific Dairy Products* v. *Siciliano*, 235 F.2d 74, 79 (9 Cir., 1956). Thus, BT has not shown how it was harmed by his absence.

BT made no offer of proof at trial as to the substance of testimony to be expected from Dr. Chu. Even at the Court of Appeals level, BT failed to make any offer of proof. BT now complains about the actions of the two Courts below, and incredibly, again fails to make any offer of proof. General and unsubstantiated allegations as to the qualifications of Dr. Chu in the antenna field are no substitute for an offer of proof as to the anticipated contents of Dr. Chu's testimony.

BT's failure to make any offer of proof as to the substance of the testimony expected from Dr. Chu, and the absence of any showing as to why his testimony was otherwise unavailable is one of the main bases of the decision of the Court of Appeals (A. 55) and it is quite applicable in this Court.

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[11] (A.) is a page reference to the Appendix.
(JA.) is a page reference to JFD's Supplemental Appendix.

Knowing that Dr. Chu might not be able to be present at trial, BT did not adequately prepare for this eventuality. See, *Davis* v. *United Fruit Co.*, 402 F.2d 328, 330-31 (2 Cir. 1968); cert. den., 393 U.S. 1085 (1969).

The first relevant postponement of the trial date is embodied in an Order of the District Court, dated October 23, 1967, and setting December 18, 1967 for trial (A. 131-32. This delay was at BT's request (A. 131). BT could, therefore, be certain that between October 23 and December 18, a period of almost two months, there would be no hearings or trials at which its witnesses and its experts would have to testify. This two-month period was sufficient for BT's attorneys to ensure that all proposed witnesses, including its expert, Dr. Chu, took care of personal matters so they could be present at trial.

On December 18, the rescheduled trial date, the Court below, not having completed the trial preceding trial of the present action (A. 145-48), ordered the present case held for trial on December 20. On December 20, the trial was scheduled after the Christmas recess for December 26. With the motion by BT to delay the trial of this action even further (A. 134), the trial in fact began on December 28 (A. 149), a mere ten days (including the Christmas recess) after the originally scheduled December 18 date. BT's attorneys knew or should have known that trial judges take cases on the trial calendar in order (A. 145-47), *Davis* v. *United Fruit Co., supra,* whereby there are bound to be Court imposed delays of trial dates as the lengths of trials are unpredictable. Furthermore, the attorneys knew the present case was complex and would require many trial days. Since BT was ready on December 18, after having two months for its witnesses to complete personal matters, BT's attorneys should have taken such steps as were necessary to ensure that BT was able to remain ready a mere ten days more.

Furthermore, the other parties were ready for trial and had their witnesses present in Court (A. 147), whereby if the trial had been delayed, they would have been penalized for being prepared and BT would have been rewarded for being unprepared.

In moving on December 22, 1967 for a further adjournment of the trial of this action (A. 135-39), BT's attorneys referred to the unavailability only of Mr. Blonder and Dr. Chu as witnesses. In fact, Blonder was present at trial and was dismissed on January 12, 1968. (JA. 20, 29). Blonder was qualified as a technical expert by BT's attorneys. (See, A. 333-35 where BT's attorney qualified Mr. Blonder). BT, therefore, had its expert on antennas. If BT feels it was without an expert, only it is to blame.

Furthermore, the first day of trial was December 28, 1967, a date which BT knew about since December 20. The Plaintiff Foundation did not rest its affirmative case until January 2, 1968 (JA. 3, A. 196, 208) six calendar, or four trial days later. From December 20, BT had thirteen days to prepare another expert to testify with respect to its own case. Its failure to obtain an expert was its own fault.

Complaints as to the unavailability of BT's president, Mr. Blonder, as a witness for BT in this trial, are ridiculous. Mr. Blonder was present at trial and provided extensive testimony on many matters relating to BT's case. (At A. 333, page 703 of the Trial Transcript, Mr. Blonder's trial testimony began and the testimony continued to A. 363, page 1020 of the Trial Transcript.)

The Denial by the Court Below of BT's Motion for a Continuance of the Trial of this Action to a Future Date was Proper.

"A motion to stay [the trial of an action] is addressed to the sound discretion of the Court, and the denial or grant of a stay is predicated upon the inherent power of a Court to control its docket." *Childers Food Inc.* v.

Rockingham Paultry Marketing Coop., 203 F. Supp. 794, 796 (W.D. Va., 1962); *Scholl* v. *Felmont Oil Corp.*, 327 F.2d 697, 700 (2 Cir., 1964); *Davis* v. *United Fruit Co.*, 402 F.2d 328 (2 Cir., 1968); cert. den. 393 U.S. 1085 (1969); *Cash* v. *Murphy*, 339 F.2d 757 (5 Cir., 1964); *Zach Metal Co.*, v. *The S.S. Birmingham City*, 291 F.2d 451, 455 (2 Cir. 1961).

Mr. Rines, BT's chief counsel, who stated (JA. 7) that he is a very experienced trial attorney, having tried "hundreds of cases," complains that the supposed "hostility" of the trial judge toward him prevented BT's obtaining a fair trial.

The Record does not indicate that BT was hindered by the trial Judge from presenting all of the evidence available to it. Certainly, none of the episodes, to which BT makes reference on p. 22 of its Brief, shows any deprivation of due process at trial. In none of these episodes was BT precluded from presenting necessary proof. The fact that the trial Judge may have expressed annoyance at certain actions of BT's counsel did not prejudice BT, because the case was tried before a Judge, not a jury, who might be prejudiced by a Judge's remarks.

The Judge also expressed annoyance at actions of counsel for both the Foundation and JFD (JA. 1-7, 9, 11-12), and thus showed no partiality toward BT's counsel.

There is no evidence that the trial Judge was unable to render a just decision on the facts and merits of the case.

BT also complains about the exclusion of certain documents, testimony and evidence which it sought to introduce. The specific items are now considered.

As noted at A. 208, and as admitted on p. 22 of the BT Brief, BT called Prof. Mayes of the University of Illinois as its own expert witness. Prof. Mayes had not previously been called to give testimony at this trial. BT maintains that certain testimony, which it was prevented by the Court

from eliciting from Prof. Mayes, should have been permitted. At A. 214-16, and particularly at A. 222-223, BT's attorney asked Prof. Mayes about a report, DX-7, and asked Prof. Mayes to compare this report with work done by Dwight Isbell, another pioneer inventor in the log periodic antenna field. These questions were indefinite because they asked Prof. Mayes for his opinion as to what another person, Isbell, had done, without defining the work of Isbell on which the witness was to comment, and they were improper because they asked the witness to make a comparison, and draw a conclusion, which invaded the province of the trial Judge. Furthermore, the words speak for themselves, without requiring Prof. Mayes' interpretive facilities. The Court of Appeals did not believe that the trial Judge was in error in excluding such testimony.

At A. 223-24, BT's attorney asked Mayes to indicate on the drawings of his own patent a particular element, which is referred to in the specification portion of the patent. This was objectionable because a patent is a legal document and the trial Judge is certainly able to interpret a legal document. The document speaks for itself. The Court of Appeals did not believe such holding to be incorrect.

BT's attorney, at A. 225, asked Prof. Mayes whether he or the University of Illinois derived financial benefit from Mayes' patent. The University is not a party to this action and the questions concerning it are irrelevant. Prof. Mayes was not an Officer of the University (A. 235), whereby he could not make any binding statements for the University. The only purpose of the question as to Prof. Mayes' own financial interest was to impeach him. Prof. Mayes had been called by and was testifying for BT as its own witness. A party is not permitted to impeach its own witness unless he is hostile. The Court below found, as a matter of fact, that Prof. Mayes was not a hostile witness (A. 230), and that BT could not impeach him. BT

obtained the desired testimony from Prof. Mayes at A. 317-18 anyhow, whereby its exclusion at A. 225 was harmless.

At A. 226, BT's attorney asked Prof. Mayes whether he had any relationship with JFD. The question was out of the order in which proof was to be presented. The order of proof had been set by a Court Order filed April 21, 1967 (JA. 36-37). At that part of the trial, BT was presenting its defense to the Foundation's claim of patent infringement. The JFD-Mayes relationship is irrelevant to the patent infringement issue.

At A. 228-30, BT was precluded by the Court from eliciting testimony from Prof. Mayes concerning alleged fraud in the Patent Office in obtaining Mayes' patent. At this time, Mayes was BT's own witness and BT's purpose in obtaining this evidence was to impeach both Mayes and his patent. BT could not then impeach Mayes because the Court found him not to be a hostile witness (A. 230).

At A. 336-41, JA. 10-11, BT attempts to gain admission into evidence of DX-35, an advertisement of JFD. DX-35 is dated prior to the issuance of BT's own patent (A. 337-38, 340), which patent is the subject of the patent infringement Counterclaim by BT against JFD. DX-35 is thus irrelevant to that Counterclaim since BT then had no patent rights, which might have been violated by DX-35 or the antennas it concerned, until after its patent issued. DX-35 is also dated before October 1963, when BT entered the antenna business, whereby this advertisement could not have been unfairly competitve with an antenna business that had not yet even begun. BT failed to lay a sufficient foundation for admission of DX-35 and it was inadmissible.

In view of the foregoing, it is respectfully submitted that BT was not deprived of due process at trial and has not made a sufficient showing to justify a reversal of the decision of the Court below.

If BT Was Denied Due Process at Trial, the Denial Related Only to Some of the Claims and Judgment on Those Claims as to Which There Were no Reversible Errors Should be Severed and Judgment on Them Should Be Affirmed.

The last sentence of Rule 21 FRCP states: "Any claim against a party may be severed and proceeded with separately". Thus, the Counterclaim against JFD may be severed from the claim by the Foundation against BT and the Counts of the Counterclaim may be severed from each other. *Transmirra Products Corp.* v. *Monsanto Chemical Co.*, 27 F.R.D. 482 (S.D.N.Y., 1961). See, *Leesona Corp.* v. *Cotwool Mfg. Corp.*, 204 F. Supp. 139 (W.D.S.C., 1962); app. dism., 308 F.2d 895 (4 Cir., 1962). The Judgment on those now severed claims and Counts of the Counterclaim for which there is no reversible error should be affirmed.

Any possibly reversible errors committed during the trial, viz., denial of a continuance and refusal to admit evidence, all related to the claim by the Foundation against BT for patent infringement, and none concerned the BT Counterclaim against JFD and the Foundation. On the continuance, Dr. Chu was an expert only on the Foundation's infringement claim. Blonder was BT's expert on the Counterclaim, and particularly on BT's own patent infringement Count of the Counterclaim. Thus, if the Court holds that there was reversible error at the trial of this action, the Counterclaim by BT against JFD and the Foundation should be severed from the separate patent infringement claim by the Foundation against BT and the judgment on the Counterclaim should be affirmed. If there are reversible errors in only some Counts of the Counterclaim, these should be severed and the Judgment on the remaining Counts should be affirmed.

The Foundation's claim for infringement of its patents, BT's counterclaim Count III for infringement of its own patent and BT's Counterclaim Counts I and II, respec-

tively, for unfair competition and antitrust law violation are all so distinct from each other that none of the testimony or evidence bearing on one of these also bears on any other, whereby severance will not cause unnecessary duplication of testimony.

After severance, the judgment in favor of JFD and the Foundation on those claims and Counts of the Counterclaim as to which there is no reversible error can be affirmed. Then, this Court can order a new trial of the remaining claims and Counts. There would be a great saving of a trial Court's time in not having to needlessly retry all the issues raised in the pleadings.

BT's Review of Isbell Patent
(BT's Brief, pp. 23-37)

Validity of the Isbell patent is involved in the Complaint and Answer and not in the Counterclaim against JFD. JFD, the Foundation's licensee, relies upon the Foundation's arguments in support of the Isbell patent to controvert BT's discussion thereof.

QUESTION 4

JFD Did Not Have Access to the Foundation's Application for the Isbell Patent or to the Patent Office with Respect Thereto and Did Not Participate in the Alleged Fraud in the Patent Office.

(Responding to BT Br. pp. 38 and 53)

The University of Illinois, the assignor of the Foundation, obtained U. S. Patent No. Re. 25,740 without concert or cooperation with JFD. Because all patents are clothed with a presumption of validity when they issue, after its issuance, JFD had no reason to challenge the manner in which the patent was obtained, since it had no knowledge or notice of any wrongdoing and had no reason to inquire

as to the manner in which the patent had been acquired. JFD had a non-exclusive license and no right to bring or defend any action which involved the validity of the patent. *Channel Master Corp.* v. *JFD Electronics Corp.*, 260 F. Supp. 568 (E.D.N.Y., 1966); reargument denied, 262 F. Supp. 292 (E.D.N.Y., 1967).

Both the District Court (A. 82) and the Court of Appeals (A. 67-68) each made an express finding of fact that there had been no fraud practiced by the University in the Patent Office. These concurrent findings of the trial and appeal courts should be affirmed here. *Faulkner* v. *Gibbs*, 338 U.S. 267, 268 (1949); *Graver Tank & Mfg. Co.* v. *Linde Air Products Co.*, 336 U.S. 271, 275 (1949). But, even if there had been fraud, neither the District Court (A. 81-82), nor the Court of Appeals (A. 66-68) at all implicated, or even mentioned, JFD as a party to the fraud. BT has not even made any showing that JFD was involved in any alleged fraud. Being a mere innocent non-exclusive licensee, JFD cannot be found liable for any fraud of the University.

JFD advertised its antennas after the patents issued as being patented antennas. This was truthful and is not part of an intentional conspiracy to defraud either the Patent Office or the public. That some JFD advertisements coincided with the introduction of antennas by BT was merely fortuitous. There is no showing that the advertisements in any way contributed to a diminution of BT sales, or that the advertisements were wrongful.

Unfair Competition and Antitrust
(BT's Brief, pp. 38-62)

BT's Question 4, upon which this Court granted Certiorari, does not raise any other matters than the alleged fraud, and particularly does not concern either alleged unfair competition or antitrust law violations by JFD. Therefore, this Court should not consider these issues. See,

Supreme Court Rule 40(d)(2); *General Talking Pictures Corp.* v. *Western Electric Co.*, 304 U.S. 175, 179 (1938); *Dickinson Industrial Site* v. *Cowan*, 309 U.S. 382, 389 (1940); *Trailmobile Co.* v. *Whirls*, 331 U.S. 40, 50 (1947). However, because BT briefed these issues, JFD has the following comments.

Blonder-Tongue's Unfair Competition Counterclaim I and its Anti-Trust Counterclaim II Do Not State a Cause of Action, Were Properly Dismissed in the District Court and the Dismissal in the District Court was Properly affirmed by the Court Below.

In its Counterclaim Counts I and II, BT accuses JFD of unfair competition and antitrust law violations. BT confuses several separate allegedly unfairly competitive acts by JFD to create, by innuendo, an aura of wrongdoing around JFD. BT speculates that the acts of JFD were wrongful, but more than mere speculation is required to justify such a conclusion. Yet, none of the separate and unrelated activities of JFD was wrongful. The BT General Manager, to whom its sales personnel reported (A. 366), testified that BT did not lose any customers or suffer any impairment of its good will due to the activities of JFD. (A. 366).

The District Court found, as a fact,

> "—that JFD was not guilty of any wrongful practices with regard to the marketing and sales of their antennas." (A. 88).

In its Judgment Order, the District Court held:

> "8. The Plaintiff and the Counterclaim defendant, JFD Electronics Corporation, did not commit acts of unfair competition or acts in violation of the anti-trust laws as charged in the Counterclaim." (A. 91)

BT made virtually the identical arguments to the Court of Appeals that it is making to this Court with respect to unfair competition and anti-trust law violation, and that

Court held that there was more than adequate justification for the findings of fact and conclusions of law made by the District Court.

Specifically, the Court of Appeals held, with respect to the findings of fact by the District Court (A. 68-69):

> "Blonder-Tongue made a series of charges of unfair competition and the like. The allegations included exaggerated claims in advertising, threatened litigation against competitors, improper news releases concerning litigation, intentional patent mismarking, fraud on the patent office, already discussed, raiding of Blonder-Tongue by JFD to recruit key personnel, and attempting to force customers to buy unpatented articles as a condition of obtaining patented ones.
>
> Extended discussion is unnecessary. The best that can be said in any instance is that Blonder-Tongue presented evidence from which the district court might, but was not compelled to, draw inferences supporting the particular charge. Contrary inferences were equally, or more, reasonable. The findings made were not clearly erroneous, the standards applied as to fairness of trade practices were appropriate, and we agree with the conclusions reached."

These findings, now having been made by two levels of Courts, should not be disturbed, as BT has not made any showing that any of the findings is clearly erroneous. *Faulkner* v. *Gibbs*, 338 U.S. 267, 268 (1949); *Graver Tank & Mfg. Co.* v. *Linde Air Products Co.*, 336 U.S. 271, 275 (1949).

BT has presented no basis for considering together a number of separate, unrelated, all legally proper acts, or for torturing these acts into a finding of unfair competition or violation of the anti-trust laws.

We now turn to BT's arguments with respect to each of JFD's unrelated activities.

BT's arguments are substantially identical to those which were rejected in the Court of Appeals:

1. JFD Did Not Coerce Tie-In Sales.

(Responding to BT Br. p. 46)

The District Court, affirmed by the Court below, found as a fact:

> "Blonder-Tongue has also argued that JFD attempted to force its customers to purchase its unpatented products as a "tie-in" with its patented products. . . . The only evidence, however, which tends to support this argument is the testimony of a JFD official who admitted that JFD salesmen would try to persuade their customers to handle not only JFD antennas but its other products as well. This is a normal business practice: all salesmen try to sell their entire line of merchandise rather than merely their most popular products. *There was no probative evidence here of any coercion or threats* made to customers to force their purchase of the entire JFD line". (A. 87-88) [Emphasis supplied.]

No evidence was presented at trial to counter the Court's finding. The JFD testimony quoted in BT's Brief supports this finding. It is natural for any producer to want its customers to handle only its line of products. JFD would be happy if its salesmen sold the entire line of JFD products but there is no evidence that they were required or expected to sell all customers the entire line. (See DX-42, p. 75). There is no evidence that JFD customers were not free to pick and choose as each saw fit.

BT unsuccessfully attempts to distort the testimony of Mr. Finkel, appearing at pages 73-76 of the transcript of his deposition, DX-42, to demonstrate tie-in selling. However, Mr. Finkel testified that he had *not* authorized JFD's salesmen to tell JFD customers that if they handled infringing antennas they might be sued. Finkel did not know of any JFD salesmen who had made declarations of this type.

While it would have been proper to have warned JFD customers that they could be sued for infringement if they infringed the patents under which JFD was licensed, there is no evidence that even this type of warning was ever made. The mere statement of a wish by Mr. Finkel that his salesmen could sell the entire JFD line does not amount to an admission of tie-in sales, and this was found both by the District Court and by the Court of Appeals below.

In the absence of any actual evidence of any coercion by JFD of BT customers, BT distorts the testimony of its own witnesses in a vain attempt to show coercion.

Mr. Helhoski was BT's General Manager, Special Accounts, and formerly Director of Marketing, (JA 26). Contrary to BT's assertion, Helhoski testified that he had no written reports or direct proof of coercion, that JFD's coercion could only be *inferred* and that such inferences could be drawn only from BT's unsuccessful antenna operation (JA 26-28).

Similarly, Mr. Gilbert, the General Manager of BT, (A. 366) testified only that he could not point to any report of or instance of coerced or tie-in sales and that all he heard was "talk" about it. (JA 22-23).

Finally, BT's Product Manager, Mr. Cohn (A. 363), testified that he knew of no tie-in sales (A. 365).

No BT salesmen produced evidence as to alleged customer coercion. If customers had been forced by JFD to buy certain products, they should have been sufficiently incensed to testify about it. The testimony of BT's employees amounts to merely repeating vague rumors. This is insufficient.

Realizing the deficiencies of its own case, BT tries to pass the obligation for proving BT's case to JFD. BT has mistakenly confused its having come forward with a miniscule quantity of testimony concerning very remotely

the allegation that JFD had engaged in tie-in sales, with BT's having to show by a preponderance of the evidence that JFD had actually attempted to make tie-in sales or had coerced BT's customers. Since BT failed to present even a *prima facie* case, JFD had no obligation to reply.

BT now presents two lame excuses for its admitted absence of proof of JFD's coercion and tie-in sales. First, it maintains that the loss of Mr. Balash, its employee, precluded its submitting proof of coercion. Mr. Balash's transfer to JFD is more extensively reviewed by BT in the next portion of its Brief, and we likewise treat this issue in greater detail in our corresponding next section. It is sufficient at this point to note, however, that Mr. Balash left BT long before the trial of this action and that BT had more than ample opportunity to gather other evidence of tie-in sales. Balash's departure was not the result of nor did it bring about any wrongdoing, which inured to the benefit of JFD.

Furthermore, BT had once taken the deposition of Mr. Balash in connection with this action (JA. 20) and could certainly have taken his deposition again if BT had any reason to think that there was any evidence in Mr. Balash's knowledge or possession, which could have been of use to BT. The lack of any deposition from Mr. Balash on this point shows that Mr. Balash's absence had no bearing on BT's ability to prove coercion.

As to the absence of Graham Sisson, the West Coast sales representative of BT, BT made no showing that Mr. Sisson had any knowledge concerning tie-in sales, cites no evidence that there were any tie-in sales efforts on the West Coast of the United States, presents no reasons why Mr. Sisson's deposition was not taken in connection with the action, and/or why he was not called as a witness at the trial of the action, presents no statement as to the evidence which Mr. Sisson would be expected to produce and,

therefore, has not shown how Mr. Sisson's transfer away from BT is in any way relevant to the alleged tie-in sales.

BT cites a number of cases, but they do not complete the deficiency in the evidence. All of these cases deal with a patent owner's coercion of customers into buying unpatented items under the threat of the denial to the customer of patented items. The record in this case is void of a showing that JFD engaged in tie-in sales activities or coercion.

The findings of the District Court and the Court of Appeals as to the absence of tie-in sales and coercion should be affirmed by this Court since no basis has been shown for holding these findings to have been clearly erroneous.

2. JFD Did Not "Raid" BT for Employees.

(Responding to BT Br. p. 50)

Between March 1966 and December 1967 (almost two years), five BT employees transferred from BT to JFD. During the same period, a total of about 100 employees left BT (JA. 12). Based on this alone, the District Court was justified in finding as a fact (A. 87):

> "Those employees later hired by JFD made up a small fraction of the total number of employees who left Blonder-Tongue during the same period of time, and a number of reasons, such as dissatisfaction with Blonder-Tongue, genuinely arrived at, appear from the evidence to have been instrumental in causing the employees to change their positions. The record contains no evidence that JFD "raided" Blonder-Tongue. *Dempster Bros., Inc.* v. *Perfection Steel Body Co.*, 182 F. Supp. 307, 309 (N.D. Ohio 1959)."

This finding was affirmed by the Court below. See, *Credit Bur. Mgmt. Co.* v. *Huie*, 254 F. Supp. 547, 552 (E.D. Ark. 1966).

No evidence of a campaign by JFD to raid BT personnel was presented. The employees came over individually, not in a mass. There are about twelve widely scattered producers in the commercial antenna field (A. 354) and JFD in Brooklyn, New York (A. 590) received a disproportionately small number of the personnel from BT, nearby in Newark, New Jersey (A. 38), even though geography favored a transfer to JFD. No trade secrets of BT were compromised by the transfers to JFD.

BT claims that the persons who transferred from BT to JFD were "key" personnel. The District Court found as a fact that this was "mere speculation" and stated that "more than mere speculation is required to justify such a conclusion. There must be proof, and such proof is lacking here." (A. 87).

BT seeks to puff up the importance of one of the employees who transferred, Jerome Balash. One BT employee testified that Balash was "the organizer of Blonder-Tongue's complete antenna business. . . . from the marketing standpoint" (JA. 29) and Mr. Blonder, BT's President, testified that Mr. Balash was later home products manager in charge of antennas at BT. (JA. 8).

However, the bulk of the evidence presented by BT shows Balash was not important at BT. Gilbert, General Manager of BT (A. 366) testified that Helhoski, and not Balash, organized the antenna business of BT (JA. 24). Gilbert also testified that Balash was being moved out of BT's antenna business (JA. 23-24). Rather than being a key employee in July 1966, when Balash decided to leave BT, his importance to BT was continuously diminishing, and by May 1966, he had been relieved of all but "nominal" duties in connection with antennas (JA. 23-24).

The circumstances of Balash's leaving BT for JFD are important here too. Gilbert indicated that Balash had frequently expressed dissatisfaction with BT (JA. 24).

From the very earliest part of Balash's career, he was looking around for another job (JA. 24). BT's Product Manager, Cohn (A. 363), confirmed that Balash had complained about and was dissatisfied with his job at BT (JA. 21).

Balash's first contact with JFD was at his instance after he heard JFD was looking for a salesman (JA. 20). Thus, active solicitation by JFD was not responsible for Balash leaving BT.

BT personnel testified that after Balash left BT certain documents could not be located (JA. 9, 23, 25-26, 28). However, BT admits that there is no evidence Balash misappropriated any BT documents (JA. 26, 28). In fact, the missing documents were kept on an open shelf from which anyone might have removed them (JA. 26).

There is no evidence that JFD received any documents from Balash, or received any information from BT records, or made use of any BT records. BT, therefore, came to no harm, vis-a-vis JFD, as a result of the alleged loss of BT documents.

BT claims that Balash was assigned to determine why customers were not buying antennas from BT, and kept related records, which BT could not locate after Balash left (JA. 8-9). If, as BT claims (JA. 23), Balash had knowledge of improper JFD practices, and of reasons for loss of customers, BT was negligent in the manner in which it ensured that the evidence alleged to be in Balash's possession was preserved. Balash notified BT in July 1966 of his plan to depart (JA. 20-21) and left nearly a month later. During this period, evidence and documents, if any, which Balash had gathered could have been obtained from him. The present action was commenced in March 1966, well before Balash gave BT notice he was leaving. Therefore, if the evidence allegedly being gathered by Balash was significant, BT should have taken steps to preserve it.

However, it was not until after Balash left BT that BT first searched for the evidence alleged to have been in Balash's posession (JA. 9-10, 25, 28). It was negligent for BT not to have checked on the location of this evidence before Balash had departed.

The documents whose alleged disappearance was first discovered after Balash's departure did not contain information exclusively within the expertise or knowledge of Balash. Such information could have been gathered by others after Balash's departure and up to the time of the trial of this action in late 1967, a period of almost 1½ years. BT shows no evidence of any effort to reproduce the alleged mising material. Thus, the alleged importance of any missing documents must be questioned.

BT took Balash's deposition (JA. 20) in connection with this action, but did not question Balash either about missing documents or about why BT was losing customers. Thus, there is no direct testimoney as to why any evidence may have been missing.

In summary, the transfer of Balash from BT to JFD was not part of any wrongdoing by JFD.

BT points to other employees who transferred from BT to JFD. There is no evidence that JFD recruited these transfers. The evidence is to the contrary (JA. 33-34). No records or trade secrets are alleged to have been lost or misappropriated as a result of these transfers.

BT complains about JFD's hiring away of Schenfeld on the "eve of trial". However, he actually left "in the middle of the year '67" (JA. 7), about six months before trial (A. 149). Schenfeld may have made performance tests on JFD antennas, and BT may have wished to have Schenfeld testify about these tests. No showing, hover, was made by BT as to why it could not have taken Schenfeld's deposition to preserve the test results, or as to why Schenfeld had not prepared a test report or as to why others did not make

similar tests during the six months before trial. If Mr. Blonder could not testify as to Schenfeld's performance tests even though he had been qualified as an expert by BT (A. 333-35), and even though Shenfeld's tests had been performed at Blonder's direction and with his knowledge (JA. 8), then Blonder himself could have performed tests (see A. 345), or another expert should have been qualified in the time available.

As for the three other BT employees who transferred to JFD, no irreparable harm was suffered by BT due to these transfers, and there is no evidence that BT was in any way hampered in its preparation for trial.

Hiring former employees of a competitor is a proper activity, *Koehring Co.* v. *National Automatic Tool Co.*, 257 F. Supp. 282, 290 (S.D. Ind., 1966); affd., 385 F.2d 414 (7 Cir., 1967); *Dempster Bros., Inc.* v. *Perfection Steel Body Co.*, 182 F. Supp. 307 (N.D. Ohio, 1959); affd., 286 F.2d 430 (6 Cir., 1960) It is wrong only if it involves the misappropriation of trade secrets. This is the only point made in and the only holding of the inapplicable *Sugar Creek Creamery* case cited by BT. There is no evidence that any trade secrets of BT were lost. See, *E. W. Bliss Co.* v. *Struthers-Dunn, Inc.*, 408 F.2d 1108, 1113 (8 Cir. 1969).

In view of the foregoing, it is absurd to maintain that the few personnel who transferred from BT to JFD did so as a result of personnel "raiding" by JFD.

3. BT's Charge of Fraud in the Patent Office.

(Responding to BT Br. p. 53)

This is a repetition of BT Br. p. 38, *et seq.* and has been treated in this Brief, *ante* p. 21.

4. JFD Did Not Mismark or Use False Patent Legends; But If Its Patent Legends Were Not Completely Accurate, Inaccuracies Occurred Through Inadvertent Error and Had No More Than Minimal Effect.

(Responding to BT Br. p. 54)

JFD has been the nonexclusive licensee of the Foundation under all its log periodic antenna patents and pending applications since 1962. At the time the 1962 License (DX-44) was entered into, only three licensed patents had issued, namely DX-65, 66 and 67. The initial JFD advertisements for log periodic antennas manufactured under license from the Foundation recited only those licensed patents that had already issued, and told the trade that the antennas came from the developments made at the University (DX-42, p. 42). Since the JFD antennas were log periodic and manufactured under the license agreement and the patents were licensed under the same agreement, there was a logical relationship between the antennas shown in the JFD advertisements and the patent numbers recited in the advertisements, and especially in those advertisements making reference to the license from the Foundation to JFD, whereby there was no mismarking.

The JFD statement about issued licensed patents provided information as to the then issued log periodic antenna patents.

JFD was first notified in or about April 1964 that its statements about the issued licensed patents might be misinterpreted. JFD thereafter took steps to change the patent legend it used. (See JFD's Finkel's letter of April 21, 1964 (DX-42-B-105). There is no showing that prior to the Finkel letter DX-42-B-105, cited by BT that JFD had notice or knowledge that its patent legends might be incorrect.

The changed notice subsequently used by JFD declared that the JFD manufactured log periodic antennas were: "Licensed under one or more of U. S. Patents 2,958,081;

2,985,879; 3,011,168; and patents pending in U. S. A. and Canada." (See the advertisements DX-42-B-106 and 113, which were cited by BT in its Brief.) Clearly, this revised form of patent legend is proper, *U.S.* v. *General Electric Co.*, 82 F. Supp. 753, 817 (D.N.J., 1949). Cf., *Rohr Aircraft Corp.* v. *Rubber Teck Inc.*, 266 F. 2d 613, 623-24 (9 Cir., 1959). The legend is truthful. It informs a person who desires to manufacture a log periodic antenna and to circumvent the Foundation's patent rights on log periodic antennas, that he should at least check the patents listed in the patent legend.

It may readily be concluded that due to inadvertence or lack of knowledge on the part of JFD or on the part of the person preparing the ad, the words "Licensed under one or more of" at the beginning of the legend and the words "and patents pending in U.S.A. and Canada" at the end of the legend were left off the initial JFD advertisements. There has been no showing by BT that the legend was shortened by JFD with intent to deceive. The District Court found as a fact (A. 85) that the "mismarking", if any, was not "deliberate".

Even if there was mismarking, it was found as a fact by the District Court that it did not have "damaging effect" A. 85). The Court continued:

> "Its effect, if any, was minimal. There was no convincing evidence to support the conclusion that potential purchasers were influenced by such markings to buy or not to buy either JFD's or its competitors' antennas, or that such markings were deliberately intended to gain an unfair adventage over JFD's competition. *S. W. Farber, Inc.* v. *Texas Instruments, Inc.*, 230 F. Supp. 883, 892 (D. Del., 1964); affd., 344 F. 2d 957 (3 Cir., 1965); cert. den. 382 U.S. 843 (1965)."

Cf., *Falcon Lock Co.* v. *Best Universal Tack Co.*, 362 F.2d 221, 223 (9 Cir., 1966), and *Hayes Spray Gun Co.* v. *E. C. Brown Co.*, 291 F.2d 319, 327 (9th Cir., 1961). JFD's patent

markings, which served as notices to the trade, were adopted only in good faith by JFD and are not evidence of unfair competition.

BT has presented no evidence to overturn the finding that the alleged mismarking had only minimal, if any, effect. BT, to recover, must show special damages, which it has not done. *Smith Victor Corp.* v. *Sylvania Electric Products, Inc.*, 242 F. Supp. 302, 308, 312 (N.D. Ill., 1965).

JFD's product line consists of approximately fifty different log periodic antennas. The Record shows very few uses of an allegedly improper patent legend. Therefore, JFD was not conducting a concerted campaign to mislead. The advertisements complained of were very limited in scope and in the effect they could have had on the market for antennas.

There is no evidence in the Record that JFD's patent legend dissuaded any BT customers from purchasing BT's "log periodic antennas". Surely, if BT had direct evidence of its customers being dissuaded, it would have introduced it. In neither of the two sections of the Record cited by BT is there mention of mismarking or of its effect on BT's customers.

The cases that are cited by BT all deal with intentional and repeated mismarking and misrepresentations. None of the cases, therefore, is relevant to the present action.

In summary, there was no mismarking by JFD. But, even if it should be found that there was mismarking, it was inadvertent. BT has made no showing of any damage to BT from the alleged mismarking, and the alleged mismarking was minimal in scope.

5. The Foundation Properly Brought the Present Action and It Was Proper for the Foundation and JFD to Have Circularized the Trade to Inform Them of the Pending Litigation.

(Responding to BT Br. p. 57)

The Foundation commenced the present action in the United States District Court for the Northern District of

Illinois, a venue to which BT never objected during the entire course, of the trial, and which venue, as the District Court found, did not work to the competitive disadvantage of BT (A. 86).

After the present action was properly commenced by the Foundation, some of BT's customers received the three documents cited by BT, which noted the pendency of the BT litigation. Only one of these, the JFD Sales Bulletin of April 19, 1966, was issued by JFD. The Foundation news release was issued by the Foundation, not JFD, and the newspaper clipping was disseminated by an independent organization.

The single Foundation and JFD news releases were distributed for information purposes. Distributors for and customers of infringers of the Foundation patents could properly be sued for infringement by the Foundation. Therefore, informing the distributors and customers about the pending actions was a service to enable the recipients to take what steps they deemed necessary for their own protection.

The District Court, as affirmed by the Court of Appeals, found the entire distribution of news releases and the like documents, and particularly JFD's part in this distribution, to be wholly proper and not excessive (A. 86):

> "... [But Blonder-Tongue's complaint is ... that news releases concerning this litigation were 'deliberately widely circulated in the trade,' and that such practices 'far transcend the proper use of patents and patent litigation.' A review of the evidence demonstrates clearly that such allegations are wholly without basis in fact. The patentee, in the belief that its patents were valid and infringed (as they have indeed been shown to be), had the right to protect its claim by notifying the trade of alleged infringements. Its activities here were not unreasonable. *Al-Fab Aluminum Fabricators, Inc.* v. *Wagner,* 220 F. Supp. 715 (N.D. Ill. 1963).]"

Such concurrent findings are supported by the record and have not been shown to be clearly erroneous.

BT notes that the JFD Bulletin lists five pending actions, and lists the one against BT first. All five cases are listed in equal size type and are arranged alphabetically. Thus, BT's name naturally appears first. The news releases were not used by JFD to discriminate against weaker competitors. Note that Channel Master, which BT admits is the largest antenna manufacturer (A. 367), appears on the list.

There was no expressed or implied threat to force customers to purchase all antennas of a particular type from JFD. BT maintains that its customers were threatened with suit if they took on the BT antenna line. The Blonder testimony cited by BT is merely hearsay. No direct evidence of such threats was introduced. Finkel of JFD speculated that such threats might have occurred, but there is no direct evidence that they did. If customers were threatened, at least some of them should have been sufficiently incensed against JFD, the threatener, to appear and testify on behalf of BT. Yet, BT produced no customers. There was no evidence of a prolonged, concerted advertising campaign with the purpose of intimidating the trade into dealing with no one but JFD.

JFD referred to the Foundation patents as "basic Log Periodic Patents". This has not been shown to be untrue. At worst, it is mere advertising "puffing". The statement is certainly no threat to the antenna distributors of BT who are regularly in the antenna business, and has not been shown to have caused BT any damage. *Smith Victor Corp.* v. *Sylvania Electric Products, Inc.*, 242 F. Supp. 302, 308, 312 (N.D. Ill., 1965).

Following commencement of an action, the distribution of a letter and of a separate "news release" to customers is proper. *Bryan* v. *Sid W. Richardson, Inc.*, 254 F.2d 191,

198 (5 Cir. 1958). *Al-Fab Aluminum Fabricators, Inc.* v. *Wagner,* 220 F. Supp. 715 (N.D. Ill., 1963); *Everybody's Tool & Die Works, Inc.* v. *Costa,* 9 F. Supp. 440 (E.D.N.Y., 1934).

BT makes some wild, irrelevant charges about this action being improperly brought and without jurisdiction, solely for the purpose of circularizing the trade. These charges are so fanciful that they are not even dignified with citations either to the Record or to case law.

All of the cases cited by BT to support its point of view are so factually distinguishable from the situation in the present action that they do not support a finding against JFD. In both *Panay* and in *Maytag,* the patent owner intentionally made misrepresentations concerning infringement in unduly repetitious and extensive advertisements. The citation to Toulmin's text is aimed at the same activities. In *Gerosa* the patent holder misrepresented, and defamed the defendant in circulars to the trade. In *Robbins,* the patent owner unnecessarily interfered with the defendant's business, brought an excessive number of infringement actions against the defendant's customers, and made other excessive demands and threats against the customers.

In the present action, there was no misrepresentation by JFD, no excessive advertising by JFD and no illegal interference by JFD in BT's business. Thus, JFD's informing the trade of the pendency of this action was proper.

6. JFD Is Not Guilty of False Advertising.

(Responding to BT Br. p. 59)

JFD never claimed that the log periodic formula, *per se,* was patented. The District Court found, as a fact, that the use of the phrase "the Patented Log Periodic Cellular

Formula" was not unfair (A. 85). The District Court reviewed this phrase further:

> "JFD maintains that it referred to the antenna itself, log periodic antenna using the patented cellular concept. This is a reasonable construction of the phrase; the reader was not necessarily led to believe that JFD had patented the whole concept of log periodicity" (A. 85).

Log periodic antennas are designed in accordance with a mathematical formula or equation setting forth the relationship between the lengths of the dipoles, each of which is a pair of outwardly extending arms, of the antenna and the spacings between adjacent dipoles (A. 75-76).

BT chooses to interpret the phrases it quotes from JFD ads, which phrases, we might add, are taken completely out of the context of the ads in which they appear, to mean that JFD is asserting that the log periodic equation in accordance with which its antennas are designed, is patented. Yet, the word "formula" has often been used to describe an article by reciting its constituent parts and the proportions and dimensions thereof. The "Log Periodic Cellular Formula" describes a log periodic antenna designed in accordance with a particular *cellular* concept, and such an antenna is claimed in U. S. Patent No. Re. 25,740 (PX-20). In the JFD advertisement DX-42-B-4A, JFD refers to "the original Log-Periodic design formula", showing that JFD means the word "formula" to denote an antenna design, not an equation.

Some of the patent claims at the end of the patent just mentioned recite the mathematical equation in accordance with which log periodic antennas are frequently designed. The only acceptable interpretation of the JFD advertisement is that JFD is referring to an antenna designed in accordance with the claims of the patent.

For example, the text, without *any* deletions, of one of the statements in the JFD advertisement, DX-42-B-4A, cited by BT, reads:

> "Do Not Be Misled by Log-Periodic Imitations or Misleading Patent Claims.
>
> There Is Only One Genuine Patented Log Periodic V-Antenna—the JFD LPV!
>
> Only JFD is licensed exclusively by the University of Illinois Foundation to make the patented Log Periodic LPV and all other Log-Periodic type TV and FM antennas."

The ad text extolls the virtues of the JFD antennas. No dealer-distributor customer in the antenna field who read this ad which appeared in a trade journal, *Radio & Television Weekly,* could have been coerced into buying only from JFD by this text. It is, at worst, mere harmless "puffing".

The same ad continues, . . . "No other so-called Log-Periodic Antenna can work like the JFD Log-Periodic LPV . . .". BT quotes the text this far and halts. But, the text goes on: ". . . because only JFD uses the original patented Log Periodic design formula of the Antenna Research Laboratories of the University of Illinois." With the complete text, the statement is seen to be true.

The advertisement DX-42-B-4A recites that JFD is licensed by the Foundation and says that the developments leading up to the patent were made at the Antenna Research Laboratories of the University by Prof. Mayes. JFD is proud that Prof. Mayes of the University made the development and is proud that it has a license under the Mayes patent. Furthermore, JFD's statements about the patented Log Periodic Cellular Formula and about the connection with the University harmlessly attempt to create an aura of technological supremacy for JFD's antennas.

JFD was not attempting to coerce the trade to deal only with JFD. BT has not shown any special damage due to JFD's advertising claims. Thus, JFD's statements are not actionable. *Smith Victor Corp.* v. *Sylvania Electric Products, Inc.*, 242 F. Supp. 302, 308, 312 (N.D. Ill., 1965).

BT points to a statement contained in a letter, DX-42-B-104, from the Foundation, the patent owner, to JFD that the log periodic formula is not patented. This letter was written by the Foundation to JFD in response to an inquiry made by JFD, as required by the license agreement between the parties to determine whether JFD's advertisements were acceptable to the Foundation. Out of an excess of caution and with a conservative outlook, the Foundation merely stated that it objected to the statement in the advertisement. The Foundation never "complained" as to the advertisement. Furthermore, JFD has no control over the Foundation and the assertions and conclusions of the Foundation are not binding upon JFD.

BT next turns to a statement by JFD as to the performance of one of its antennas and maintains that JFD misrepresented the facts. However, the Record is devoid of any evidence of false technical claims by JFD.

The only testimony which challenged the technical claims by JFD was presented by BT's president, Blonder (A. 345-46). However, it would be improper to consider this testimony to prove that JFD's technical claims were false, first, because Blonder's testimony was introduced for a special purpose, not the purpose for which it has now sought to be used, and second, because the testimony was later stricken from the Record. At A. 341, BT makes a first effort to gain admission of DX-32, a JFD advertisement. Blonder's testimony at A. 345-46 was *solely* for the purpose of gaining admission of DX-32 into evidence (JA. 11). The objection to the admission of DX-32

was finally sustained (A. 367-68). With its exclusion from evidence, the testimony used solely as a foundation for its admission should also be excluded from consideration. Blonder's testimony, taken only for the limited purpose of laying a foundation for introduction of DX-32, cannot now be used for the purpose of challenging JFD's technical claims.

The testimony BT sought to use concerns a performance test performed by Blonder on a JFD antenna. Blonder described the test range, or location used for testing the JFD antenna, as being the roof of BT's factory (A. 345). No testimony was presented to show that this test range was adequate. It may have been blocked by adjacent structures, it may have been in a poor reception zone or there may have been interference from other radiation emitters.

Blonder said the test was performed under his supervision. His obvious bias in trying to disprove the truth of any JFD technical claim cannot be ignored. Blonder tested only a single sample of a JFD antenna (A. 346) at only one allegedly critical channel (A. 346), and did not even bother to record the test results (A. 346). Consequently, his test results should be accorded no probative value. A test on an alleged single critical channel is not sufficient to substantiate a broad claim that JFD's antenna did not perform on all channels as claimed.

JFD did not present any evidence as to its technical claim because no showing, which was properly receivable in evidence, was made that JFD had misrepresented the performance of its antennas.

Even if the claim by JFD was exaggerated, the claim applies to only one of the many antennas in JFD's line. There are six antennas shown in the LPV line in JFD's advertisements, DX-42-B-102 and in DX-42-B-109. JFD's technical claim with respect to one antenna, therefore, could

have had only a very limited effect. Also, the performance claim in DX-42-B-102 is buried near the end of three pages of text and is not emphasized. The claim in DX-42-B-109 is hidden in the second page of text of the advertisement and is not emphasized. It is unlikely, therefore, that many customers came across or were influenced by these passages. JFD's advertising has been quite extensive and there is small likelihood that a customer would see or remember these segments of these particular advertisements, in the broad context of JFD's advertising.

To further support its claim of allegerly being harmed, BT asserts that in the same period that JFD was making its performance claims, BT was advertising the *true* performance figures for its own DART antenna. However, on p. 4 of X-JFD-23 (A. 727), BT shows a stylized representation of an antenna response curve showing an infinite front-to-back ratio, which is perfection. This is an impossibility in the real world, and is, therefore, an apparently inaccurate representation of true performance. BT's misrepresentation constitutes unclean hands, and BT cannot now be heard to raise a misrepresentation charge against JFD.

Furthermore, BT's obviously exaggerated performance claim shows that it is common practice in the trade to exaggerate performance characterists of an antenna. *Bechik Products, Inc.* v. *Federal Silk Mills, Inc.*, 135 F. Supp. 570, 579 (D. Md., 1955). Consequently, if JFD exaggerated, this is an acceptable trade practice of "puffing" rather than an intentional misrepresentation.

BT cites a letter from the Foundation to JFD, DX-42-B-112 calling JFD's advertising claims "a gimmick" and threatening to cancel the license agreement. In fact, the threat was related to JFD's not having submitted its advertising to the Foundation for prior approval, as required by the license agreement. The threat had nothing to do with JFD's publicity as to performance. Besides,

since JFD has no control over the Foundation, statements it makes are not binding upon JFD. Furthermore, use of a "gimmick" is acceptable. Gimmicks sell products and aggressive competition is desirable. *Drop Dead Co.* v. *S. C. Johnson & Son, Inc.*, 326 F.2d 87, 95-96 (9 Cir., 1963); cert den., 377 U.S. 907 (1964).

BT's Antitrust Counterclaim was Frivolously Asserted, was not even Seriously Prosecuted and is without Merit.

In its pleadings, BT asserted that JFD violated the antitrust laws. (A. 26-27, 43).

BT did not even make a *prima facie* showing of a violation of the antitrust laws, and, in fact, did not even attempt to introduce sufficient evidence to make such a showing. After listening to the meager evidence which BT relied upon for its finding of a violation of the antitrust laws (JA. 16-19, A. 347-53), the trial Judge rightly characterized the whole charge as a sham. At A. 353, the Court said:

> "We know that these antitrust counter-claims are filed—shall I say routinely—in patent cases, certain patent cases, and I get a little weary of seeing prayers in countercomplaints for preliminary injunction as a result of alleged violations of the Sherman Act not pursued at all. To me this has always smacked of a lack of dignity. . . . I don't like those things if they are not substantiated."

Because of the absence of proof concerning an antitrust law violation and because the antitrust claim was asserted by BT to have some relationship to the alleged acts of unfair competition, the District Court treated the unfair competition and antitrust counterclaims together. Its entire Opinion on these counterclaims was devoted to the unfair competition issue (see A. 84-88). The Opinion of the Court of Appeals similarly emphasizes the alleged unfair competition because BT made no effort to prove its antitrust claim in that Court. The antitrust counterclaim should, therefore, not even be considered by this Court.

Only under intensive cross-examination by JFD's counsel was any basis at all for BT's antitrust counterclaim stated. At A. 350-51, BT's president indicated that the only basis for BT's charge under the antitrust laws was that JFD had published a number of advertisements for its antennas, which advertisements are discussed in connection with the unfair competition counterclaim, and which advertisements made some mention of the Foundation patents under which JFD was licensed. On such a meager showing of unlawful activity, it is no wonder that the Courts below did not treat the antitrust counterclaim seriously.

BT could have taken additional testimoney from its own witnesses or JFD's witnesses or it could have obtained testimony, at trial or through depositions, from persons and business concerns who were injured by the allegedly illegal activity. That BT did not even endeavor to introduce such testimony indicates that it had no belief in the strength of its own antitrust counterclaim.

Summary as to the Unfair Competition and Anti-Trust Counts.

BT has raised a number of insubstantial arguments concerning allegedly unfairly competitive acts by JFD, and, by innuendo, has attempted to label JFD as an unfair competitor, when as a matter of law, this is not the case. The above discussion clearly shows that none of these acts was wrongful. If any of these acts were improper, none of them was intentionally so. Throughout BT's many pages of innuendo, not one probative instance of actual or actionable damage caused by JFD to BT has been shown. JFD's advertising and publicity program has the necessary result of fostering competition, which is what the anti-trust laws are intended to encourage. *Drop Dead Co.* v. *S. C. Johnson & Son, Inc.*, 326 F.2d 87, 95-96 (9 Cir., 1963); cert. den., 377 U.S. 907 (1964); *Bailey's Bakery Ltd.* v. *Continental Baking Co.*, 235 F. Supp. 705, 718 (D. Hawaii, 1964).

In view of the foregoing, the holding of the Court below on the unfair competition and anti-trust Counts of BT's Counterclaim should be affirmed.

QUESTION NO. 5

Petitioner's Patent is Invalid

Scope of Question No. 5

Question No. 5 asks whther it is mandatory for lower courts, when dealing with the "obvious" provision of 35 U.S.C. 103, to make the three inquiries formulated by this court in *Graham* v. *Deere,* 383 U.S. 1 (1966). The sufficiency of the Court of Appeals opinion in this regard is not referred to in Question No. 5. However, in petitioner's Statement of the Case and Argument, the sufficiency of findings in the opinions of both courts below with respect to "obviousness" are assailed. The petitioner dilutes the question thus posed by also asserting that it has been deprived of a right to present expert testimony with respect to its own U. S. Patent No. 3,259,904 to Blonder et al DX-26 (A. 525).

Both courts below found that Claim 5 of the Blonder et al patent was invalid, and neither court considered whether Claim 5 had been infringed.

The sole issues fairly embraced by Question No. 5 are whether the suggestions by this Court in *Graham* v. *Deere,* supra, concerning inquiries for determining "obviousness" under § 103 are mandatory, and if the making of such inquiries is required by the circumstances of this case, did the District Court make such inquiries, and if it failed to do so, did the Court of Appeals make such inquiries.

This Court declared that the § 103 condition for patentability:

> "lends itself to several basic factual inquiries" (383 U.S. 1, 17),

and went on to state:

> "We believe that the strict observance of the requirement laid down here will result in that uniformity and definiteness which Congress called for in the 1952 Act." (383 U.S. 1, 18)

The above language "lends itself" and "We believe" constitutes an outline of a reasonable line of approach where the facts warrant the approach and where no other approach is available or is used.

In *Anderson's-Black Rock, Inc.* v. *Pavement Salvage Co.*, 396 U.S. 57 (1969), after restating the inquiries suggested in the *Graham* case with respect to § 103 "obviousness", this Court, using more forceful language than in *Graham*, declared:

> "We admonish that 'strict observance' of those requirements is necessary." (396 U.S. 57, 62)

This Court clearly intended that inquiry be made by the lower courts but just as clearly did not intend to prohibit lower courts from resorting to any logical procedures deemed appropriate to determine whether the "obviousness" requirement of § 103 has or has not been met. In accordance with the circumstances of a particular case, the controlling consideration is whether the opinion of a lower court sets forth a sufficient factual basis for a holding predicated on the "obviousness" provision of § 103. The Trial Court and the Court of Appeals made the necessary inquiry, each in its own way, the Court of Appeals going out of its way to show it was fully aware of the requirements of *Graham* v. *Deere*.

As will hereinafter be seen, even if it is suggested that the opinion of the District Court is insufficient in this regard, the opinion of the Court of Appeals cures any possible insufficiency. Thus, the holding that Claim 5 of the Blonder et al patent is invalid should be affirmed.

The Opinions Below Contain the Required Findings to Support a Holding of Invalidity Under 35 U.S.C. 103

Even though the District Court could have made more findings of fact than it actually made, its opinion was clear enough for both the Court of Appeals and petitioner to recognize the factual basis for the conclusion that Claim 5 is invalid under § 103. The Court of Appeals was able from the record to make the findings suggested by *Graham* v. *Deere*. Any alleged error committed by the District Court in making its findings, if such error existed, was cured by the Court of Appeals and did not require remand by that Court on the issue of patent invalidity. *Leighton* v. *One William Street Fund, Inc.*, 343 F.2d 565, 567 (2 Cir. 1965); *Swain* v. *Boeing Airplane Co.*, 337 F.2d 940 (2 Cir., 1964), cert. den. 85 S. Ct. 1083; *Urbain* v. *Knapp Bros. Mfg. Co.*, 217 F.2d 810 (7 Cir. 1954).

More important, in this particular case, since a full adequate Record was made at trial and since the issue of patent invalidity depends upon interpretation of written documents and examination of physical exhibits, the Court of Appeals was able to make, and did make, its own findings[12] addressed to each of the "obviousness" inquiries suggested in the *Graham* decision

As for the scope and content of the prior art, the Court of Appeals found that Mr. Blonder, one of the coinventors, "testified that all the mechanical elements in claim 5 were old" (A. 70), and that a substantial separation of dipole located "planes is clearly shown * * * in the 1961 publication * * *, Technical Report No. 52, of the Antenna Laboratory". (A. 70)

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[12] *Seligson* v. *Roth*, 402 F. 2d 883, 887 (9 Cir. 1968) and *B. F. Goodrich* v. *Rubber Latex Products Inc.*, 400 F. 2d 401, 403 (6 Cir., 1968).

As for the difference between claim 5 and the prior art, the Court of Appeals noted that:

> "Blonder-Tongue places chief reliance upon the fact that while *Isbell* teaches that the two planes in which the dipole elements lie are to be close enough together so that the dipoles are substantially coplanar, *Blonder* teaches that the planes may be separated by some distance, but less than the wavelength of the band". (A. 70)

As for the level of ordinary skill in the art, the Court of Appeals, after discussing the subject matter of the Blonder et al patent, found that:

> "The very nature of the subject matter suggests that it was directed at the type of problems which might be solved when addressed by persons with ordinary skill in the art". (A. 69)

Thus, it is clear that the Court of Appeals meticulously followed the suggested line of inquiry set forth in the *Graham* opinion and made findings sufficient to support the holding that Claim 5 is "obvious" within the meaning of § 103.

Accordingly, the holding of the Court of Appeals that Claim 5 of the Blonder et al patent is invalid is not properly subject to a technical attack as failing to follow the *Graham* case, and such holding should be affirmed.

Further, under the circumstances of this particular case, even the opinion of the District Court contains sufficient findings to show that the Court had made those § 103 inquiries suggested in the *Graham* case:

(a) The prior art is referred to in the opinion at A. 79.

(b) The scope and content of the prior art is covered by the testimony of one coinventor who admitted that all the mechanical elements of Claim 5 were old (JA. 14); it was therefore not necessary to discuss each element in detail.

(c) The level of skill in the art is discussed in that portion of the opinion dealing with validity of the Foundation's patents.

(d) The extremely close correspondence between the prior art and Claim 5 is such that "obviousness" is clear even to one not skilled in the antenna art so that it was not necessary to determine the higher level of one skilled in such art.

(e) Blonder admitted that all structural elements of Claim 5 were known to the prior art (JA. 14), so that it was not necessary for the District Court to find that particular elements of Claim 5 were not present in the prior art.

Petitioner Has in Its Brief Raised Issues Beyond the Fair Scope of Question No. 5

All issues fairly embraced by Question No. 5 can and should be resolved without reviewing evidentiary matters. JFD's argument up to this point on Question No. 5 covers all issues fairly embraced by Question No. 5.

But, under the guise of responding to Question No. 5, petitioner has gone far beyond the scope of Question No. 5 by raising issues of due process and patent validity, and makes the naked claim that Claim 5 is infringed. See, Supreme Court Rule 40(d) (2); *General Talking Pictures Corp.* v. *Western Electric Co.*, 304 U.S. 175, 179 (1938); *Dickinson Industrial Site* v. *Cowan*, 309 U.S. 382, 389 (1940); *Trailmobile Co.* v. *Whirls*, 331 U.S. 40, 50 (1947).

As for BT allegedly being deprived of an opportunity to present expert testimony concerning the Blonder et al patent, Mr. Blonder was qualified as an expert in the art here involved (A. 333-6), and testified as BT's expert in that portion of this case charging infringement of the Blonder et al patent. Since on Page 66 of petitioner's Brief Blonder is referred to as "a masters-degree engineer", and at Trial BT's attorney referred to Blonder "as one skilled

in the art" (A. 335), petitioner should not be permitted to deny that Blonder is a technical expert.

Thus, it is clear that petitioner had the benefit of expert testimony at trial of this action.

Even though this Court should not burden itself by reviewing the Record insofar as it relates to the evidentiary matters for establishing patent invalidity, petitioner has gone beyond the scope of Question No. 5 and attacked the substantive basis for holding Claim 5 invalid.

Both courts below found Claim 5 to be invalid.

If this court feels compelled to consider this issue, reference is made to the arguments presented by JFD to the Court of Appeals showing invalidity of Claim 5 based on prior art, file wrapper estoppel, lack of invention, inoperativeness, indefiniteness, and insufficient disclosure. These arguments are set forth in detail in Addendum A of this brief entitled "Claim 5 of BT's U.S. Patent No. 3,259,904 (DX-26) Is Invalid".

BT's Assertions of Patent Validity Are Misleading and Irrelevant

The assertions in paragraphs numbered 1 through 8 on pp. 64-66 of Petitioner's Brief are misleading in their attack on the finding of obviousness. In Paragraphs 1 through 3 the most pertinent prior art citations, viz. Technical Report 52, X-JFD-10 (A. 705), the Mayes Antenna, X-JFD-13 and the Heslin Antenna, X-JFD-8D are not considered. Neither Mr. Blonder's testimony nor the Blonder et al patent (DX-26) (A. 525) refers to this prior art.

As to Paragraphs 4 and 5 on p. 65 of Petitioner's Brief, the prior art is not limited to commercially available items. The alleged improvement of Claim 5 was taught by any one or a combination of X-JFD-10, 13 or 8D and prior art patents. By relying upon 35 U.S.C., Sec. 103 ("obviousness") rather than upon 35 U.S.C., Sec. 102 (direct antici-

pation), both Courts below recognized, that no single reference taught each and every element of Claim 5. However, a combination of references, such as in the chart X-JFD-14, shows the alleged invention of Claim 5 to be "obvious".

As to paragraph 6, testimony concerning surprise as to the success of his invention was not unexpected when coming from Blonder, one of the inventors of the BT patent in suit. Heslin's testmony (JA. 29-31) refers to surprise if he could feed his own 72 ohm antenna X-JFD-8D with a 300 ohm open wire line and obtain desired results without using a coupler. (See discussion concerning high SWR beginning at JA. 29.) Heslin was not concerned with BT's antenna in this testimony. The BT patent in suit DX-26 does not show or teach means for avoiding a high SWR when there is a large mismatch between the impedance characteristic of an antenna and the impedance of the transmission line feeding such antenna, and there is nothing of record to show that such a result is possible without using a coupler (transformer). In fact, instruction sheet X-JFD-26C (JA. 41) for BT's Color Ranger 3 antenna, at the middle of paragraph 4, states that "a matching transformer is required" when using coaxial cable (72 ohm) with the Color Ranger 3, since the latter is designed to operate with 300 ohm cable or twinlead.

As to paragraphs 7 and 8 on p. 66 of Petitioner's Brief, even though the Isbell and Mayes, et al patents were cited by the Patent Office, this does not indicate that the Patent Office knew of the more pertinent prior art cited by JFD in this action, including X-JFD-10, 13 and 8D. BT suggests that JFD copied its twin boom antennas from BT. However, the twin boom antenna, X-JFD-13, was built for the JFD consultant Dr. Mayes in 1961 (JA. 34), and he was designing twin boom antennas, including the LPV-VU-18 of DX-27A, for JFD in the Spring of 1963 (JA. 35), while the BT TV antennas did not reach the market place until the Fall of 1963 (JA. 7).

The allegedly "relatively widely spaced booms" of the Blonder-Schenfeld construction were part of the prior art to Blonder, et al, such as X-JFD-10 and 3A (JA. 705 and 673). In fact, X-JFD-3A suggests a spacing of as much as 7.75 inches, while the Blonder-Schenfeld spacing is only 1.0 inch (A. 526). (Col. 2, line 51 of DX-26.) This argument concerning alleged wide spacing of Blonder-Schenfeld's booms raises an irrelevant issue since Claim 5 of DX-26 does *not* require that the longitudinal conductors (booms) be widely spaced. The only requirement in Claim 5 is that the booms be spaced vertically in a vertical plane and that the boom spacing be less than the spacing between dipoles. Without referring to the Isbell and Mayes and Carrel patents PX-1 (A. 399) and 20 (A. 404), it is clear that the prior art antenna of Heslin (X-JFD-8D) includes booms spaced vertically in a vertical plane as does the prior art Mayes antenna (X-JFD-13). Further, the prior art Technical Report No. 52 X-JFD-10 (A. 705) shows a log periodic antenna with parallel booms spaced vertically in a vertical plane (Fig. 6 of X-JFD-10) (A. 709).

Furthermore, twin boom antenna structures fed at the front end by parallel-wire transmission lines were known in the prior art. See Technical Report 52, X-JFD-10, at p. 18. There is no suggestion in the Blonder et al. patent DX-26 that the parallel-wire transmission line mounting and feed feature illustrated therein is critical, as BT now asserts in paragraph 8. This feature is not essential because the performance of the antenna shown in Figure 1 of DX-26 would not deteriortate if the transmission line was brought directly from the connecting points 1″ and 1‴ to the standoff on mast M without passing through guide portions 2′ and 4′ (JA. 35). This last mentioned manner of mounting the transmission line (which does not use the allegedly critical feature) is the recommended way of using BT's log periodic twin boom antenna Ranger 3 (See instruction sheet X-JFD-26C) (JA. 41). The Ranger 3 is claimed by Blonder to be covered by Claim 5 (JA. 12). The limitation in the patent, therefore, is not critical since BT's own an-

tenna allgedly covered by the patent, does not include this construction.

In addition, the BT Ranger 3 (X-JFD-26A) does not include even one standoff for supporting the transmission line. Not only is this transmission line support not critical, but the provision of standoffs or strain reliefs connected to antenna booms and positioned adjacent to the point of connection for twin lead was admitted by Blonder to be old in the art (JA. 12). X-JFD-4A, 4B, (A. 702), 5A, 5B (A. 704), 5C show examples of prior art constructions for boom mounted standoffs positioned adjacent to the twin lead connecting points separated by insulators labelled 100 in X-JFD-4A, 4B (A. 702), 5A.

The doctrine of *Minneapolis-Honeywell Regulator Co.* v. *Midwestern Instruments, Inc.*, 298 F. 2d 36, 38 (7 Cir., 1962), cited on pages 64 and 68 of petitioner's brief as a basis for criticizing the quantity of prior art cited by JFD, is not in point in that in this case much of the prior art was cited merely to show the similarities between the prior art and JFD's accused antennas. One approach taken by JFD on invalidity requires the combination of only two prior art references (See Chart X-JFD-14 at JA. 39). The Court of Appeals found that the alleged improvement of claim 5 was shown in Technical Report 52, X-JFD-10 (A. 705) and the District Court found invalidity on four different grounds with each of three of these grounds referring to but a single prior art reference.

Infringement

Infringement of the Blonder, et al patent is far beyond the scope of Question No. 5 and would require detailed study of voluminous evidence. The finding of invalidity by both Courts below rendered moot the question of infringement. Hence, neither opinion below makes reference, either directly or indirectly, to whether the accused JFD antennas come within the scope of claim 5.

Conclusion as to Question No. 5

The Court of Appeals meticulously made the inquiries suggested by *Graham* and by doing so cured any defect in this regard that may have been present in the opinion of the District Court. The findings and opinion of the trial court provided the material for the findings made in specific *Graham* v. *Deere* form by Court of Appeals.

Issues of due process, patent validity, and patent infringement are beyond the fair scope of Question No. 5 and should not be considered by this Court.

Accordingly, the Court of Appeals holding that Claim 5 of the Blonder et al patent is invalid should be affirmed.

Conclusion

There is no error in the decision of the Court of Appeals. There is no basis for holding that any finding was clearly erroneous. There is, therefore, no basis for reversing the decision of that Court with respect to validity of the Isbell patent, the invalidity of the Blonder-Schenfeld patent, the holding that there was no fraud in procurement or use of the Isbell patent or that there was no basis whatever for the charge of violation of the anti-trust laws or the charge of unfair competition.

The decision of the Court of Appeals should be affirmed.

Respectfully submitted,

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ADDENDUM A.

CLAIM 5 of BT's U.S. PATENT NO. 3,259,904 (DX-26) IS INVALID

The Antenna of the BT Patent

The antenna in Figure 1 of DX-26 (A. 525) is a so-called twin boom antenna constructed to receive television and radio signals, and embodies all of the limitations of Claim 5 (A. 527). The antenna is mounted to vertically extending mast M, and includes parallel horizontally extending conductors 1, 1′ (otherwise known as twin booms) positioned one above the other. A plurality of dipoles 5-11 and 5′-11′ are arranged with one element of each dipole being connected to the other boom. Alternate dipole elements on each boom extend in opposite directions. The dipole elements gradually increase in length from the fronts to the backs of the booms. Insulators 2 and 4 maintain booms 1, 1′ in vertical spaced relationship, with insulator 2 also maintaining the looped terminal portions 1″, 1‴ (takeoff points) at the forward ends of the booms in spaced apart relationship. Terminals 1″, 1‴ are provided for the electrical connection of transmission line TL (described as a parallel-wire type and otherwise known as twin lead) to the antenna. Guide portions 2′ and 4′ formed integrally with the respective insulators 2 and 4 support the transmission line TL in the region between terminals 1″ and 1‴ and the standoff or strain relief on mast M.

Presumption of Patent Validity Has Been Rebutted

There is a presumption of validity of the Blonder et al patent, DX-26 (A. 525), which arises from its having been granted. This presumption is greatly weakened because the prior art contains teachings which show the obviousness of the alleged improvement in Claim 5 more clearly than any references cited against the patent during its prosecution

before the Patent Office. *B. & M. Corp.* v. *Koolvent Aluminum Awning Corp.*, 156 F. Supp. 691; aff. 257 F. 2d 264 (7 Cir., 1958); *Kennatrack Corporation* v. *Stanley Works*, 314 F. 2d 164, 167 (7 Cir., 1963); *Day-Brite Lighting, Inc.* v. *Sandee Manufacturing Co.*, 286 F. 2d 596, 597 (7 Cir. 1961).

Technical Report No. 52, X-JFD-10 (A. 705), physical exhibits of prior art log periodic twin boom antennas, and prior art strain relief members were not cited against the application for patent DX-26. Validity Chart X-JFD-14 (JA. 39) demonstrates that all but one structural element of Claim 5 (A. 527) of DX-26 is taught by Technical Report No. 52 X-JFD-10 (A. 705), viz., a conventional strain relief member functioning in its ordinary manner. Prior art strain relief members appear in X-JFD-4A and 4B (A. 702) (Channel Master's Line Lok) and in X-JFD-5A, 5B (A. 704) and 5C (JFD's Zip antenna).

The Mayes antenna, X-JFD-13, and the Heslin antenna, X-JFD-8D, are both log periodic twin boom structures which had been built and operated long prior to any proven date of conception for the alleged invasion of DX-26. Each may be combined with a conventional strain relief member, resulting in a structure identical to that defined by Claim 5 of DX-26. Additional pertinent prior art patents to Kane '703 (X-JFD-3A) (A. 673), Wickersham '976 (X-JFD-3B) (A. 676), Valach '801 (X-JFD-3C) (A. 682), Gross 146 (X-JFD-3d) (A. 688), Winegard 195 (X-JFD-3E) (A. 691), and Callaghan '010 (X-JFD-3F) (A. 696), each not considered by the Patent Examiner, were introduced at the trial to negate generalized puffing statements made by the co-inventor Blonder and/or to show similarities between structural elements of the accused JFD antennas and the prior art.

Claim 5 is Invalid—Prior Art

Complete anticipation in a single prior art reference is not necessary to invalidate a patent claim. 35 U.S.C., Sec. 103 expressly provides:

> "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."

With respect to Sec. 103, this Court has stated that it—

> "was not intended by Congress to change the general level of patentable invention. We conclude that the section was intended merely as a codification of judicial precedents embracing the Hotchkiss condition." *Graham* v. *John Deere Company of Kansas City* (1966) 383 U.S. 1, 17.

In line with the statute, United States courts have held repeatedly that "to obtain the privileged position of a patent, more ingenuity must be involved than the work of a mechanic skilled in the art." *Noble Co.* v. *S. C. Johnson Co.*, 241 F. 2d 469, 479; 112 USPQ 350, 357 (7 Cir., 1957).

Technical Report No. 52, X-JFD-10 (A. 705), prepared at the Antenna Laboratory of The University of Illinois and published in 1961, clearly teaches all but one of the elements recited in Claim 5, arranged in the precise combination specified in Claim 5. The only element of Claim 5 possibly not found in Technical Report No. 52 is a strain relief or "means for supporting the transmission line near the said one end" (end of the booms to which the transmission line is electrically connected). Examples of suitable strain re-

liefs are the Line Lok of X-JFD-4A & 4B (A. 702) and Zip antenna X-JFD-5A, 5B (A. 704) & 5C. This is pictorially illustrated in Validity Chart X-JFD-14 (JA. 39) which Prof. Mayes testified was accurate (A. 384).

Co-inventor Blonder admits that prior to the alleged invention of DX-26, it was known to secure strain relief members to the boom of an antenna in the region of terminals for connecting a transmission line to the antenna and for supporting the line (JA. 12).

Validity Chart X-JFD-14 (JA. 39) pictorially illustrates the foregoing in connection with the teachings of Technical Report 52, X-JFD-10 (A. 705). Professor Mayes was consulted during preparation of Chart X-JFD-14. He agrees with the opinion stated on Chart X-JFD-14 and believes that the remaining contents of Chart X-JFD-14 are accurate. (A. 384).

With the exception of a conventional strain relief means required by Claim 5 of DX-26, all elements of Claim 5 are disclosed by Technical Report No. 52 X-JFD-10 (A. 705). All elements recited by Claim 5 are admitted to be old by one of the co-inventors (JA. 14). As this Court said:

> "The mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them is not patentable invention." *Lincoln Engineering Co. of Illinois* v. *Stewart Warner Corp.*, 303 U.S. 545, 549 (1938).

See, *A & P Tea Co.* v. *Supermarket Corp.* 340 U.S. 147, 152 (1950); *Dow Chemical Co.* v. *Halliburton Oil Well Cementing Co.*, 324 U.S. 320, 328, (1945).

While it seems clear that either the Line Lok strain relief, X-JFD-4A and 4B (A. 702). or the Zip strain relief, X-JFD-5A, 5B (A. 704) and 5C, when combined with either of the

physical antennas of Heslin, X-JFD-8D, or Mayes, X-JFD-13, or with the antenna disclosed in Technical Report No. 52, X-JFD-10 (A. 705), will serve to invalidate Claim 5 of DX-26, in the interests of reasonable thoroughness, brief comments will be made upon other pertinent prior art patents, X-JFD-3A through 3F inclusive (A. 673-96).

The use of rigid insulators to space twin parallel booms in an antenna structure is taught by Gross '146, X-JFD-3D (A. 688), beginning at line 51, col. 1 (A. 375). Figure 2 of Valach '801, X-JFD-3C (A. 682), shows the halves of a dipole vertically spaced in a vertical plane. (A. 378).

The adjustment of input impedance by varying the spacing between booms in a parallel boom antenna structure is taught by Kane '703, X-JFD-3A (A. 673), in the first full paragraph of col. 2 (A. 374), by Gross '146, X-JFD-3D (A. 688), in the first full paragraph of col. 2 (A. 375), and by Wickersham Jr., et al '976, X-JFD-3B (A. 676), at the end of the first paragraph in col 3 (A. 374). This teaching is also contained in Technical Report No. 52, X-JFD-10 (A. 705), on p. 88. (A. 375).

Callaghan '010, X-JFD-3F (A. 696), teaches the use of mast mounted standoffs (Fig. 3) and, in col. 4, line 51, et seq., points out that for television purposes, the transmission line should be kept taut to prevent movement which will produce flutter on the T.V. screen (A. 378). Winegard '195, X-JFD-3E (A. 691), especially in Figure 1, shows that parallel wire transmission line 50 is supported by a mast mounted standoff in the region adjacent to the points where transmission line 50 is connected to the antenna (A. 374). Note that in Figure 1 of X-JFD-3E the parallel conductors 35, 36 constitute a wire form impedance transformer (A. 373). Conductors 35, 36 to which transmission line 50 is connected, are spaced apart by a much greater distance than the conductors of transmission line 50. In Figure 2 dielectric spacer 40 connected to boom 14 supports transformer 35, 36.

The assembly of old elements taught by Claim 5 (A. 527) of DX-26, performs no function or operation not performed by corresponding elements in prior art structures. Such an insubstantial contribution should not be permitted to sustain validity.

Claim 5 is Invalid—File Wrapper Estoppel

Claim 5 (A. 527) of DX-26 evolved from application Claim 13 (p. 8 of the File Wrapper, X-JFD-1, of DX-26) which was originally presented as depending from, and thereby including all of the recitations of, independent application Claim 12 (p. 8 of X-JFD-1). Application Claim 12 was originally limited to a structure in which the mounting means for the antenna comprised rigid conductive extensions of the longitudinal conductors. By Preliminary Amendment dated May 5, 1965 (p. 3 of X-JFD-1), Claim 12 was amended by deleting the aforesaid details of the means for mounting the antenna and substituting therefor:

> ". . . , rigid insulating means securing the said connecting means mechanically in spaced-apart relation and connected with means for supporting the transmission line near the said one end, and means for mounting the antenna at a region of the said conductors remote from the said one end, further rigid insulating means being provided for securing the said longitudinal conductors mechanically in rigid spaced-apart relation near the said region. . . ."

In the Office Action of 1-28-66 (p. 13 of X-JFD-1), it was indicated that Claim 13 would be allowable if it were rewritten as an independent claim, and Claim 12, as it had been amended was rejected—

> ". . . on Isbell or Greenberg. Under 35 U.S.C. 103, there is no apparent patentable significance in providing various mechanical and clamp limitations—

other than design aspects or obvious mechanical expedients. . . ."

In the next Amendment filed by the attorneys for Blonder, et al, dated April 1, 1966 (p. 15 of X-JFD-1), they acquiesced in the rejection of Claim 12 as being unpatentable, which rejection was contained in the Office Action of 1-28-66, by cancelling amended Claim 12 and transferring all its limitations to Claim 13 (patent Claim 5).

Claim 13, after it was rewritten to include all of Claim 12, differed from Claim 12 only by the inclusion in the former of the limitation:

"... the said vertical distance [between booms] being less than the distances between the said successive points [between dipoles] and less than the wave lengths of the said band . . ."

If it can be shown that the additional limitation is not patentable, since BT already conceded the rest of Claim 13 is unpatentable, all of Claim 13 is unpatentable.

The above quoted limitation in Claim 13 is shown in the patent to Isbell '767, PX-1, especially when the Isbell patent is interpreted as BT has done to convince the courts below that BT's structures do not infringe that Isbell patent. In Figure 2 of Isbell, longitudinal conductors (booms) 17, 18 are spaced apart by a vertical distance which is much less than the spacing between the closest dipole elements 19, 21. Thus, in Isbell "the . . . vertical distance [between booms] being less than the distances between the successive points [between dipoles]." Further, the vertical distance between longitudinal conductors (booms) 17, 18 in Isbell is much less than the combined lengths of the shortest dipole elements 19, 19a. The overall length of a dipole pair is typically one half the wavelength, whereby the spacing between booms is less than one-half the wave

length. The patent reads: "... The shortest element should be about 0.38 wave lengths [less than one wave length] long at the upper limit ..." (Col. 3, line 6, et seq.) where the wave length is shortest.

The limitations introduced by original application Claim 13 only impose size limits on the mechanical elements that were specified in cancelled application Claim 12. All size limitations introduced by application Claim 13 are found in Isbell '767, PX-1. Thus, Claim 5 is invalid because of file wrapper estoppel (acquiescence in the rejection of Claim 12) and invalidity over Isbell (additional limitations of Claim 13), under 35 U.S.C., Sec. 103.

Claim 5 is Invalid—Embodies No Invention

By file wrapper estoppel, (considered in the previous section hereof) Blonde admits that the only limitation (see previous section hereof) in Claim 5 (A. 527) of DX-26 that is critical and, therefore, that embodies any inventive contribution, is the limitation requiring the vertical distance between booms to be less that the distances between the dipoles (i.e., the "successive points" in Claim 5). This limitation, however, is not critical. Blonder admitted this when he answered "no" to the question:

> "Q Is there any appreciable deterioration of performance when the boom spacing exceeds the distance between the dipole elements?" (JA. 14)

Blonder said (JA. 13) that if the booms of PX-10 (a physical embodiment of the antenna shown in Figure 1 of DX-26) were spaced apart as much as three inches (approximately three times the spacing between the shorter dipoles), antenna performance would be satisfactory. Thus, Blonder admitted that it is not critical to maintain the boom spacing at less than the spacing between dipoles. Accordingly Claim 5 contains no invention.

Claim 5 is Invalid—Inoperative

The boom spacing limitation introduced by original application Claim 13 (Claim of 5 of DX-26), in requiring that the vertical distance between booms be ". . . less than the wave lengths of the said band . . .", renders the claimed invention inoperative. Co-inventor Blonder testified that the antenna of Figure 1 in DX-26 is designed to operate in the frequency band of 470-890 megacycles, where the shortest wave length is approximately 13 inches (JA. 13). Blonder further testified that if the antenna of Figure 1 in DX-26 were modified by increasing the separation between booms to 10 inches (which is still almost 25% *less* than the shortest wave length of the band), the modified antenna ". . . would not function in a manner in which I intended . . .", would not be commercially acceptable (JA. 13), and ". . . I would consider it an inadequate device . . ." (JA. 13). Therefore, the critical limitation of Claim 5 (A. 527) of DX-26 which states that the antenna will operate properly when the boom spacing is less than the wave length of the band, is misdescriptive and the claimed invention is rendered inoperative.

BT may argue that Claim 5 should be read to require that the distance between booms is "much" less than the wave lengths of the operating band for the antenna. However, Claim 13 as originally presented, specified that the boom spacing was:

> ". . . much less than the wave lengths of the said band. . . ." (p. 8 of X-JFD-1)

In an Amendment dated May 5, 1965 BT's attorneys expressly deleted "much" (p. 12 of X-JFD-1). Therefore, BT's attorneys meant that the spacing between booms may be any amount ". . . less than the wave lengths of the said band . . .". So read, the claim is incorrect and the claimed device is inoperative.

Claim 5 is Invalid—Indefinite Claim, Insufficient Supporting Disclosure

Claim 5 (A. 527) of DX-26 is also invalid because it fails to precisely define the limits of the alleged invention and fails to adequately disclose and describe the invention as required by 35 U.S.C., Sec. 112, See, *Halliburton Oil Well Cementing Co.* v. *Walker,* 329 U.S. 1, 11 (1946); *General Electric Company* v. *Wabash Appliance Corp.,* 304 U.S. 364, 369 (1938).

In particular, Claim 5 of DX-26 recites that there are:

> ". . . means for supporting the transmission line near the said one end, and means for mounting the antenna at a region of the said conductors remote from the said one end, . . .".

The specification, or description of the invention, does not define or contain any recitation as to the positional limits for the terms "near" and "remote" in connection with the location of the transmission line support or the location of the antenna mounting means. How near to one end is *near*: 1 inch, 1 foot, 2 feet, 1 dipole element away, 3 dipole elements away? How remote, also, is *remote*? BT's patent contains no disclosure, and Claim 5, therefore, cannot be understood.

The Claim, for the same reason, is invalid as being indefinite. That the term "remote", in particular, is indefinite was revealed by Blonder when he responded "yes" to the question:

> "Q. Would you agree that the word 'remote' is indefinite as applied to the device shown in defendant's Exhibit 27A?" (JA. 12).